

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Roger Orozco and Nora Orozco,)
)
 Petitioner,)
)
 v.)
)
 Michael Hwang,)
)
 Respondent.)
)

TTAB

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Cancellation No. 92043811

OPPOSITION TO RESPONDENT'S MOTION
TO STRIKE PETITIONER'S TRIAL TESTIMONY DEPOSITIONS
AND OPPOSITION TO RESPONDENT'S REQUEST
FOR LEAVE TO CROSS-EXAMINE NORA OROZCO AND TONY SUGDEN

Petitioners, Roger Orozco and Nora Orozco ("Petitioner"), respond to the Motions filed by Michael Hwang ("Respondent") as follows:

The discovery period and both Petitioner's and Respondent's testimony periods have all closed in this proceeding. On January 30, 2007, Respondent, more than two months after the depositions were completed, and after the close of its own Testimony period, filed the Motion to Strike Petitioner's Trial Testimony as untimely. In the alternative, Respondent filed a request for leave to cross-examine the two witnesses whose testimony depositions were properly noticed and already taken during Petitioner's trial testimony period.

I. Summary.

Respondent's Motions must be denied in their entirety. First, Petitioner's Trial Testimony depositions were properly noticed in writing eleven days prior to the date of the scheduled testimony depositions. The notice provided by Petitioner was clearly proper under any reading of the rules. See 37 CFR § 2.123(e)(3); TBMP §§ 533.02 and 707.03(b)(1). Furthermore, Respondent's Motion is not timely. The instant motion was filed more the two

months after the completion of Petitioner's testimony depositions and after Respondent's own testimony period. This late filing is improper under any reading of the rules. Respondent cannot be rewarded for its intentional failure to prosecute this case.

II. Background Facts.

On October 30, 2006, prior to the opening of Petitioner's Testimony period, Petitioner's counsel, Kurt Koenig, telephoned Respondent's counsel, John Johnson to request an extension of the opening of Petitioner's testimony period. (Declaration of Kurt Koenig, ("Koenig Dec"), ¶¶ 2, 6). The grounds for Mr. Koenig's request to extend the testimony dates were that Mr. Koenig's schedule was very tight in November and it may be difficult for Mr. Koenig to schedule Petitioner's trial testimony in November 2006. (Koenig Dec. ¶¶ 2, 6). Mr. John Johnson indicated he was not inclined to grant such a request and refused to grant Mr. Koenig any extension of Petitioner's Testimony period. (Koenig Dec. ¶¶ 2, 6). Therefore, on November 16, 2007, eleven days prior to the trial testimony deposition dates and fifteen days before the close of Petitioner's testimony period, Petitioner properly noticed and served the trial testimony depositions of Nora Orozco and Tony Sugden.¹ (Koenig Dec. ¶¶ 3, 6). On November 17, 2006, Mr. Koenig confirmed in an email to Mr. Johnson that since he had not heard from Mr. Johnson that Petitioner would proceed with the cancellation proceeding. Mr. Johnson never responded to Mr. Koenig. (Koenig Dec. ¶ 4, 6).

On the very day of the Testimony depositions, when counsel for Respondent knew Petitioner's counsel was not in his office, Respondent's counsel faxed a letter to Petitioner's counsel alleging they did not receive the notice with "sufficient time" and they would not be attending the deposition. (See Letter dated November 27, 2006 attached as Exhibit B to Respondent's Brief). Since Petitioner's counsel was not in the office and was in fact at the

¹ These notices were properly served by mail pursuant to 37 C.F.R. §2.119(b). Respondent opines that it prefers papers to be served by email, but as noted by Respondent, such notice would not be proper under the rules and presumably Respondent would have objected to such improper notice.

location of the deposition, Petitioner's counsel did not receive Respondent's letter until after the depositions were complete. (Koenig Dec. ¶¶ 5, 6). While the testimony was underway, Respondent's counsel never called Petitioner's counsel to leave a phone message nor did Respondent's counsel call or fax Petitioner at the location of the depositions, even though the location was noted in the Notice of Deposition. (Koenig Dec. ¶¶ 5, 6).

Respondent's brief admits the deposition notices were actually received by Respondent's counsel at least six days prior to the noticed dates. (Respondent's Brief at 3). Respondent's counsel does not supply the actual date received in its mailroom, but it was likely even earlier than November 21, 2006. In any case, the letter from Irene Hudson dated November 27, 2006, confirms that Respondent's counsel had reasonable notice of the deposition dates. Ms. Hudson chose not to file a Motion to Quash, call counsel for Petitioner, or contact the Board prior to the taking of the depositions. Instead, Ms. Hudson sent a fax to Petitioner's counsel in Santa Barbara, even though it was obvious the depositions were already taking place in Ventura. The November 27, 2006 fax letter merely indicated that Ms. Hudson would be unable to attend.

On December 1, 2006, Kurt Koenig sent a letter to Ms. Irene Hudson regarding the fact that the testimony depositions had gone forward and confirmed they were properly noticed. (Koenig Dec. ¶ 6).

A month later, on December 26, 2006, Ms. Hudson wrote a second letter which reiterated her position that the notice of deposition was improper and that the witnesses should be cross-examined. (Koenig Dec. ¶ 7). Again, Respondent failed to take any action as required by the rules until yet another month had passed and then only after Respondent's own testimony period had closed. Since the deposition notices were timely and reasonable, having been served eleven days ahead and received at least six days prior to the date of the depositions, Petitioner's counsel was not obligated to agree to Ms. Hudson's demand to set new deposition dates or make the witnesses available for cross-examination.

III. Petitioner's Notice of Trial Testimony Deposition was Reasonable.

The only issue to be decided is whether eleven days prior written notice for a trial testimony deposition is reasonable under the rules. TBMP §§ 533.02 and 707.03(b)(1). Such a motion is to be decided on the basis of all the relevant circumstances. See 37 CFR § 2.123(e)(3).

IV. Petitioner's Notice of Testimony Deposition was Reasonable.

Whether a notice is reasonable is determined under the individual circumstances of each case. See C & F Packing Company, Inc. v. Doskocil Companies, Inc., 126 FRD 662, (N.D. Ill. 1989); Electronic Industries Association v. Potega, 50 USPQ2d 1775, 1776 (TTAB 1999); Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072 (TTAB 1990); Duke University v. Hagggar Clothing Co., 54 USPQ2d 1443, (TTAB 2000). Here there is no question the notice was more than reasonable. Under no circumstances can eleven days prior written notice be considered unreasonable and under the facts of this case it was more than reasonable as outlined below.

Petitioner's eleven day advance notice of the trial testimony depositions was proper.² Respondent was quite aware of Petitioner's upcoming testimony period, because Mr. Koenig and Mr. Johnson discussed the same on October 30, 2006. (Koenig Dec. ¶ 2). Petitioner had requested an extension of time and Mr. Johnson refused to grant the same during that telephone conversation. (Koenig Dec. ¶ 2). Respondent was quite aware that Petitioner planned to go forward with its case as Mr. Koenig served notices of depositions on November 16, 2006. On November 17, 2006, Mr. Koenig also sent an email to Mr. Johnson noting that Petitioner had to move forward with its case. (Koenig Dec. ¶ 4). Respondent's brief acknowledges that Ms. Hudson personally received the Notice as early as November 21, 2006, at least six days prior to the date of the depositions. (Respondent's Brief at p. 3). Respondent was thus fully informed

² Fed. R. Civ. P. 30(b)(1) requires a party seeking to take testimony depositions upon oral examination to give every adverse party reasonable notice in writing of the time and place where the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be examined. See also Trademark Rule 2.123(c); and TBMP Sections 718.03(b) and 713.05. Duke University v. Hagggar Clothing Co., 54 USPQ2d 1443 (TTAB 2000).

that Petitioner was going to move forward with its case. (Koenig Dec. ¶ 2, 4, and Respondent's Brief at p. 3). Respondent never called Petitioner's counsel to request the depositions be rescheduled or that there was any concern about the dates. Instead, Respondent waited until Petitioner's counsel was already at the deposition location to fax a letter to Petitioner's counsel objecting to the deposition. (Koenig Dec. ¶ 5, Respondent's Brief at p. 3). The bottom line is that Respondent's counsel has admitted she received the proper notice within a timely period. Additionally, Respondent's counsel has acknowledged that she undertook no action whatsoever to object to Petitioner's trial testimony depositions until the actual day of the depositions, a full six days after proper notice was acknowledged. (Respondent's Brief at p. 3). There can be no question that Respondent was either negligent in waiting so long to file the instant motion or intentionally sent the November 27, 2006 letter at the very last minute so Respondent could later object to the deposition which Respondent never planned to attend in the first place.

All the evidence shows that the eleven days notice was more than reasonable. Respondent had more than enough time to contact Petitioner prior to the depositions, to file a motion to quash, or contact the Board for relief. Instead, Respondent waited more than two months to file the instant motion. The case law cited by Respondent simply does not support the allegation that the notice in this case was unreasonable. In fact, the case law supports the rule that even a three day notice is sufficient. Duke University at 1444. There is no support whatsoever for the notion that an eleven day written notice is improper or inadequate. On the contrary, given the fact that a trial testimony period is only open for a period of thirty days, an eleven day notice prior to a deposition is more than reasonable. Furthermore, the facts here show that Respondent's counsel was either 1) negligent in not contacting opposing counsel when they had concerns about the noticed dates or 2) intentionally waited until the depositions were underway to send a fax letter which could not be received until after the completion of the depositions. This did not even give Petitioner's counsel an opportunity to change the date of the

deposition testimony until after they were completed. Respondent was fully aware of that fact and such actions should not be rewarded.

V. Respondent failed to file a Motion to Quash.

Respondent should have filed a motion to quash prior to the taking of the properly noticed testimony depositions. A motion to quash a notice of deposition should be filed promptly after the grounds therefor become known to the moving party. TBMP § 521, n. 303. Respondent failed to file, or chose not to file, a Motion to Quash. If Respondent felt the Notice of Testimony Deposition was unreasonable or improper, Respondent should have immediately contacted Petitioner by phone and if necessary the Board. Id.³


VI. Conclusion.

There is no legal or factual support for Respondent's objection to Petitioner's trial testimony due to lack of inadequate notice. Moreover, even if the Board finds that eleven days advance notice is was insufficient, Respondent failed to preserve any objection by not moving to strike the testimony promptly as required by Trademark Rule 2.123(e)(3). Accordingly, Petitioner requests that Respondent's Motion be denied in its entirety.

Respectfully submitted,

Dated: February 20, 2007

By:


Kurt Koenig
Koenig & Associates
226 East Canon Perdido Street, Suite M
Santa Barbara, CA 93101
Tel: 805-965-4400
Fax: 805-564-8262
Attorneys for Petitioner

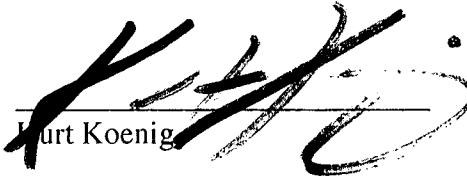
³ When time is of the essence, the moving party may telephone the Board attorney to whom the case is assigned and ask that the motion be resolved by telephone conference call. TBMP § 521 n. 307.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing "OPPOSITION TO RESPONDENT'S MOTION TO STRIKE PETITIONER'S TRIAL TESTIMONY DEPOSITIONS AND OPPOSITION TO RESPONDENT'S REQUEST FOR LEAVE TO CROSS-EXAMINE NORA OROZCO AND TONY SUGDEN" was served on February 20, 2007 by first-class mail, postage prepaid, to Applicant's counsel addressed as follows:

Mr. John Johnson
Ms. Irene Hudson
Fish & Richardson P.C.
Citigroup Center
153 E. 53rd St., 52nd Floor
New York, NY 10022-4611

Dated: February 20, 2007


Kurt Koenig

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451**, on February 20, 2007.


Kurt Koenig

Dated: February 20, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<hr/>)	
Roger Orozco and Nora Orozco,)	
)	
Petitioner,)	
)	
v.)	
)	
Michael Hwang,)	
)	
Respondent.)	
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Cancellation No. 92043811

DECLARATION OF KURT KOENIG
IN SUPPORT OF
PETITIONER'S MOTION IN OPPOSITION

I, Kurt Koenig, declare as follows:

1. I am an attorney duly licensed to practice law in the States of California and Illinois. I am a principal of the firm of Koenig & Associates, counsel of record for Petitioner in this matter. I have personal knowledge of the facts set forth herein and, if called as a witness, could and would competently testify thereto.

2. On October 30, 2006, prior to the opening of Petitioner's Testimony period, I telephoned Respondent's counsel, John Johnson to request an extension of the opening of Petitioner's testimony period. I informed Mr. Johnson that my schedule was very tight in November and it would be difficult for me to schedule the trial testimony in November. I suggested the dates be extended to allow me to better fit the required testimony into my schedule. In the course of this telephone call, Mr. Johnson indicated he was unable to grant my request for any extensions of Petitioner's Testimony period.

3. On November 16, 2007, eleven days prior to the trial testimony deposition dates and fifteen days before the close of Petitioner's testimony period, Petitioner properly noticed and

served the trial testimony depositions of Nora Orozco and Tony Sugden. A copy of the notice is attached as Exhibit A.

4. On November 17, 2006, I confirmed in an email to Mr. John Johnson that Petitioner would proceed forward with the cancellation proceeding. Mr. Johnson never responded to me in any way.

5. On November 27, 2006, I attended the Testimony depositions of Nora Orozco and Tony Sugden. Neither Respondent nor Respondent's counsel attended these properly noticed depositions. Counsel for Respondent did not provide any prior notice that counsel for Respondent would or would not attend. On November 27, 2006, the date of Petitioner's trial testimony depositions, I was not in my office because I was in Ventura, over 30 miles away, at the location of Petitioner's trial testimony depositions. Respondent's counsel did not fax any correspondence to the location where the depositions were noticed or make a telephone call to the location where the depositions were taking place. I was therefore unaware that Petitioner had objected to the deposition in any way. I checked my voice mail during the course of the deposition, but Respondent's counsel had not left me any voice mail messages indicating that they had any objection to the timing of the deposition. It was not until my return to my office in Santa Barbara on November 28, 2006 that I received Respondent's letter indicating they would not attend and an email indicating they objected to the depositions which had already been completed.

6. On December 1, 2006 I sent a letter to Ms. Irene Hudson. In this letter I asked Ms. Hudson to call me regarding the issues raised in her letter of November 28, 2006. My letter confirmed the fact the depositions were properly noticed and also confirmed the refusal of Mr. John Johnson to move the trial testimony dates for Petitioner. A copy of this letter is attached as Exhibit B.

7. On December 26, 2006, I received a letter from Ms. Irene Hudson. This letter reiterated Ms. Hudson's prior letter of November 27, 2006 in which she alleged the depositions were improperly noticed. A copy of this letter is attached as Exhibit C.

8. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made herein of her own knowledge are true; and all statements made on information and belief are believed to be true.

Dated: February 20, 2007


Kurt Koenig

Exhibit A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Roger Orozco and Nora Orozco,)

Petitioner,)

V.)

Michael Hwang,)

Respondent.)

Cancellation No. 92043811

PETITIONER'S NOTICE OF TESTIMONY DEPOSITION

Please take notice that, pursuant to Trademark Rule 2.123(c), Petitioner, Roger and Nora Orozco, by their attorney, will take the testimony deposition upon oral examination of Nora Orozco and Tony Sugden of 5235 Mission Oaks Blvd. #600, Camarillo, CA 93012 on November 27, 2006 beginning at 9:30 AM at the office of Pacific Coast Court Reporters at 1363 Donlon Street, Suite 8, Ventura, CA 93003.

The deposition(s) shall take place before a certified court reporter and shall run consecutively and continue until completed.

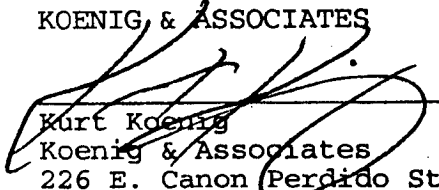
You are invited to attend and cross-examine.

Respectfully submitted,

KOENIG & ASSOCIATES

Dated: November 16, 2006

By:


Kurt Koenig

Koenig & Associates

226 E. Canon Perdido St. Suite M
Santa Barbara, CA 93101

Tel: 805-965-4400

Fax: 805-564-8262

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I, KURT KOENIG, hereby certify that I caused a copy of the foregoing "PETITIONER'S NOTICE OF TESTIMONY DEPOSITION" to be served on November 16, 2006, by first class mail, postage prepaid, addressed to:

Mr. John Johnson
Ms. Irene Hudson
Fish & Richardson P.C.
Citigroup Center
153 E. 53rd St., 52nd Floor
New York, NY 10022-4611

Dated: November 16, 2006

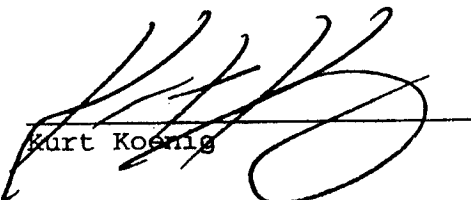

Kurt Koenig

Exhibit B

KOENIG & ASSOCIATES

ATTORNEYS AT LAW

WRITER'S EMAIL: KURT@INCIP.COM

226 EAST CANON PERDIDO, SUITE M
SANTA BARBARA, CALIFORNIA 93101
TELEPHONE: 805-965-4400

FACSIMILE: 805-564-8262

December 1, 2006

Ms. Irene Hudson
Fish & Richardson P.C.
Citigroup Center
153 E. 53rd St., 52nd Floor
New York, NY 10022-4611

Re: Roger Orozco and Nora Orozco v. Michael Hwang

Dear Irene:

I am following up on my voice mail message of November 28, 2006 in which I asked you to call me and discuss the issues in your November 27, 2006 letter. As I had noted, we went forward with the Testimony Deposition on November 27, 2006 as scheduled in the notice dated November 16, 2006.

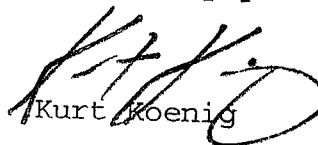
We did not receive your November 27, 2006 letter until we returned to the office the next day. We were unaware of any concerns as we did not receive a phone call from you either at our office or at the location noticed in the deposition.

In any case, the Testimony Depositions were properly noticed and served. The Testimony period is now closed.

You may recall, I had asked John Johnson if he would agree to extend the Trial dates when I spoke to him on October 30, 2006, but he would not agree to move the dates. I then had a few email exchanges with John regarding an offer of settlement. When I did not hear back from John I sent an email noting we would have to move forward with the cancellation. I still received no reply.

I would be happy to discuss. Please call me at your convenience.

Very truly yours,


Kurt Koenig

KK:mo

Exhibit C

FISH & RICHARDSON P.C.

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

Citigroup Center
153 East 53rd Street,
52nd Floor
New York, New York
10022-4611

Telephone
212 765-5070

Facsimile
212 258-2291

Web Site
www.fr.com

VIA ELECTRONIC & FIRST CLASS MAIL & FACSIMILE

December 26, 2006

Mr. Kurt Koenig
Koenig & Associates
226 E. Canon Perdido St., Suite M
Santa Barbara, California 93101

Re: Roger Orozco and Nora Orozco v. Michael Hwang
Our Ref.: 18503-002001



AUSTIN
BOSTON
DALLAS
DELAWARE
NEW YORK
SAN DIEGO
SILICON VALLEY
TWIN CITIES
WASHINGTON, DC


Dear Mr. Koenig:

Further to our letter and e-mail of November 27, 2006, we did not receive Petitioner's Notice of Testimony Deposition of Nora Orozco and Tony Sugden for November 27, 2006, in Ventura, California, with sufficient time in advance. In particular, we had at most two business days (three business days if you count the Friday after Thanksgiving Day) to prepare for and travel to California for the depositions. Due to this inadequate notice, Registrant did not have an opportunity to cross-examine the witnesses on November 27, 2006. Thus, we ask that you make Nora Orozco and Tony Sugden available for cross-examination, either by phone or in person deposition, after we have had an opportunity to review their testimony.

TBMP § 533.02, 37 C.F.R. § 2.123(e)(3) provides that "[e]very adverse party shall have full opportunity to cross-examine each witness." Pursuant to TBMP § 533.02, 37 C.F.R. § 2.123(c), "[b]efore the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined" The Trademark Trial and Appeal Board has ruled that one- and two-days notice was not reasonable and did not provide adequate notice under the circumstances. *See, e.g., Jean Patou Inc. v. Theon Inc.*, 18 U.S.P.Q.2d 1072 (TTAB 1990); *Duke University v. Haggard Clothing Co.*, 54 U.S.P.Q.2d 1443 (TTAB 2000); *Electronic Industries Association v. Potega*, 50 U.S.P.Q.2d 1775 (TTAB 1999).

We look forward to hearing from you.

Very truly yours,


Irene Hudson